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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,678	02/15/2002	John Stanley Taras	TAR-001	1674

7590

05/19/2004

David P. Gordon, Esq.  
65 Woods End Road  
Stamford, CT 06905

EXAMINER
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BAXTER, JESSICA R

ART UNIT	PAPER NUMBER
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3731

1/2

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/076,678

Applicant(s)

TARAS ET AL.

Examiner

Jessica R Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003 and 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 3, 2003 has been entered.

### ***Election/Restrictions***

2. Claims 16, 17, 21 and 22 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

3. Applicants arguments are persuasive and the restriction requirement is withdrawn. All claims will be examined.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23, 24, 26 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,870,957 to Goble et al.

Goble discloses a pin having a threaded portion provided with threads and a shaft portion, said threaded portion including a tip end and an opposite end (FIG. 3), said opposite end including a plurality of longitudinal grooves (slots 46) extending parallel to a

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longitudinal axis of said pin and located adjacent said shaft portion and spaced apart about an outermost circumference of said threaded portion, and a driver member including a socket having structure adapted to interfere with said grooves on said first portion of said pin.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4, 6, 7, 8, 9, 10-12, 14-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG-PUB 2003/0074002 to West, Jr. in view of U.S. Patent No. 5,871,486 to Huebner, further in view of EP 0 276 153 to Schilder.

West discloses a fracture pin comprising a first portion having a first diameter and first threads of a first diameter (FIG. 2), said first portion having a tip (FIG. 2) at one end and a second end, a second portion coupled to said second end of said first portion (FIG. 2), said second portion having a second diameter larger than said first diameter, and second threads of a second thread diameter larger than said first thread diameter having a common pitch and thread depth (Paragraph 0016, 0023 and 0040), said second threads extending in a same direction as said first threads (FIG. 2). West discloses the claimed invention except for the pin being solid and the second portion being provided with a plurality of longitudinal grooves spaced about an outer circumference of said second portion and a non-threaded shaft portion. Huebner teaches that bone screws may be formed with or without a lumen

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(FIGS. 5 and 18A). Schilder teaches that a non-threaded shaft portion and a plurality of grooves on a pin are used to provide the pin with an integral screwdriver and the grooves are provided to allow the screw to be removed after the non-threaded shaft portion is sheared off (Column 1 line 56-Column 2 line 15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of West with a solid portion as is well known in the art and to provide the pin with an integral non-threaded shaft portion in order to provide an integral screwdriver and to provide the pin of West with a plurality of grooves in order to provide means for withdrawing the pin after the non-threaded shaft portion is sheared off.

Regarding claims 2 and 28, West discloses that the first and second threads are continuous (Paragraph 0023).

Regarding claim 6, West discloses that said shaft portion is substantially cylindrical (FIG. 2).

Regarding claim 10, West discloses that said pin is not provided with a head portion (FIG. 2).

Regarding claim 11, West discloses that all threads on said first portion have said first thread diameter (FIG. 2).

Regarding claim 12, West discloses that said pin is made of metal (Paragraph 0045).

Regarding claims, 14, 19 and 25, West, as modified does not disclose 3 grooves spaced apart 120°. Schilder teaches providing 2 grooves (FIGS. 2 and 4). It would have been an obvious choice to provide three grooves instead of two grooves as an obvious matter of design choice.

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Regarding claims 22 and 32, West further discloses a mill tool adapted to remove bone and define an opening in the bone (Paragraph 0064). The channel in which the device is placed must be formed by a drill or mill that will remove the cut bone.

8. Claims 1, 2, 3, 5, 6, 10, 11, 12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG-PUB U.S. Patent No. 6,030,162 to Huebner in view of Huebner '486, further in view of EP 0 276 153 to Schilder.

Regarding claims 1 and 16, Huebner '162 discloses a fracture pin comprising a first portion having a first diameter and first threads of a first diameter (FIG. 20 intermediate portion 628, 928), said first portion having a tip (leading section 624) at one end and a second end, a second portion coupled to said second end of said first portion (trailing section 626, 926), said second portion having a second diameter larger than said first diameter, and second threads of a second thread diameter larger than said first thread diameter having a common pitch and thread depth (Column 9 lines 7-26), said second threads extending in a same direction as said first threads (FIG. 20). Huebner '162 discloses the claimed invention except for the pin being solid and the second portion being provided with a plurality of longitudinal grooves spaced about an outer circumference of said second portion and a non-threaded shaft portion. Huebner '486 teaches that bone screws may be formed with or without a lumen (FIGS. 5 and 18A). Schilder teaches that a non-threaded shaft portion and a plurality of grooves on a pin are used to provide the pin with a integral screwdriver and the grooves are provided to allow the screw to be removed after the non-threaded shaft portion is sheared off (Column 1 line 56-Column 2 line 15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Huebner '162 with a solid portion as is well known in the art and to

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provide the pin with an integral non-threaded shaft portion in order to provide an integral screwdriver and to provide the pin of Huebner '162 with a plurality of grooves in order to provide means for withdrawing the pin after the non-threaded shaft portion is sheared off.

Regarding claim 2, Huebner discloses that the first and second threads are continuous (Column 3 lines 36-38).

Regarding claim 3, Huebner discloses a plurality of cutting flutes (FIG. 2 teeth 36).

Regarding claim 5, Huebner discloses that the first portion has a length of approximately 2.55 inches and a first diameter of approximately .125 inch, and said second portion has a second length of approximately .6 inch and a second diameter of approximately .0015 inches (Column 5 lines 18-32).

Regarding claim 6, Huebner discloses that said shaft portion is substantially cylindrical (FIG. 20).

Regarding claim 10, Huebner discloses that said pin is not provided with a head portion (FIG. 20).

Regarding claim 11, Huebner discloses that all threads on said first portion have said first thread diameter (Column 4 lines 19-34).

Regarding claim 12, Huebner discloses that said pin is made of metal (Column 5 lines 9-17).

Regarding claim 17, Huebner discloses a mill tool having structure adapted to remove bone (Column 5 lines 42-65).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

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10. In response to applicant's argument that West is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, West discloses a threaded bone screw which is capable of being used within bone and thus be used as a fracture fixation pin.

### ***Conclusion***

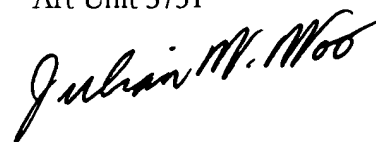
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
jrb

Jessica R Baxter  
Examiner  
Art Unit 3731



**JULIAN W. WOO**  
**PRIMARY EXAMINER**